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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,404	12/01/2000	Satoshi Nishikawa	862.C2066	1364

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EXAMINER

QIN, YIXING

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 10/06/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/726,404

Applicant(s)

NISHIKAWA, SATOSHI

Examiner

Yixing Qin

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-11 is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 recites the limitation "the change step of changing a setup." There is insufficient antecedent basis for this limitation in the claim. Claim 1 address a "change step of changing the number of sets of copies...", but it is clear that the change step in claim 4 is addressing the changing of a setup. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 4, 12,13,14,15, 17,18,19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima et al (U.S. Patent No. 6,104,498).

Regarding claims 1, 12 and 17, "a saving step of saving..." is rejected since Shima et al discloses in fig. 10 and column 12, lines 46-50, that "...data is transmitted from the host 1, first the reception task 71 starts processing upon reception of the data at step T1, performs data reception processing at step T2, and stores the received data in the reception buffer 83, then transmits data at step T3." Also, in fig. 8 and column 9,

lines 18-21, Shima et al discloses M, "...wherein M is a number-of-copies register..."

Although Shima et al does not explicitly teach the saving of the data and the number of copies in the same storage unit, it would have been obvious to one of ordinary skill in the art at the time of the invention to have stored the data and the number of copies together in one storage unit. The motivation is to save space with less storage units.

Further regarding claims 1, 12 and 17, "a discrimination step of discriminating..." is rejected since Shima et al discloses in fig. 12 and column 13, lines 66-67 that "Whether or not test print is to be executed is determined at step S59." The purpose of this step is to determine which of the two possible instructions (test print or "regular" print) is to take place.

Further regarding claims 1, 12 and 17, "a change step of changing..." is rejected since Shima et al discloses in fig. 14 and column 14, lines 18-21, that "FIG. 14 show a flow for test printing of one copy at the beginning before M copies of P-page print information are printed."

Further regarding claims 1, 12 and 17, "an output step of outputting..." is rejected since Shima et al discloses in column 3, lines 28-43, that there is a "...means for storing the data and the intermediate print information, print management means for issuing a print execution instruction based on print specifications of print information contained in the data according to interpretation of the job language interpretation

means, and print execution means for converting the intermediate print information into bit image data and executing print based on the instruction of the print management means.” In regards to the number of copies, Shima et al discloses in column 4, line 9, “...multiple-copy print...” in the sixth form of the invention. Therefore it would have been obvious to one of the ordinary skill in the art at the time of the invention to output the data with the number of copies together. The motivation is to ensure the proper numbers of the appropriate data is printed.

Regarding claims 2, 13 and 18, “...a delete step of deleting...” is rejected since Shima et al discloses in fig. 9 and column 10, lines 1-3, that “If the number of copies is reached, all information read from the storage means and printed is deleted from the storage means at step S39.”

Regarding claim 3, 14, and 19, “...a step of decreasing...” is rejected since Shima et al discloses in fig. 13 and column 14, lines 13-15, that “If the test print is OK, print of the second page to the Pth page is executed at steps S74-S77. Next, the remaining (M-1) copies are printed at steps S78-S83.” The M that Shima et al refers to a register that keeps track of the number of copies the job has. The point is that Shima et al is reducing the number of copies left to print since the test copy can simply be used as one of the copies that is needed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to only print the remaining

copies of the total number of copies if the test copy is deemed to be OK. The motivation is to save paper when printing.

Regarding claim 4, 15 and 20, "...the data stored in the storage unit is intermediate data..." is rejected since Shima et al discloses in column 3, lines 28-5 that "...format conversion means for converting a format of the print information to prepare intermediate print information, means for storing the data and the intermediate print information..." and "...the storage means consists of a RAM and auxiliary storage means ...". In regards to the "...change step of changing the setup associated...", Shima et al discloses in column 3, lines 18-23, that their invention "...enables[s] print specifications to be changed even after print information is transmitted..." The idea behind Shima et al's statement is that there is no need to retransmit information; it can simply be changed "on the fly." Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include intermediate print data and the ability to change that data without the need for retransmission of the data. The motivation is to save time in data transmission.

Claims 5, 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima et al (U.S. Patent No. 6,104,498) and further in view of Williams et al (U.S. Patent No. 5,237,923).

Regarding claims 5, 16 and 21, the Shima et al reference discloses all the limitations of claim 5 except for "...the step of resetting the designated number of sets of copies..." The secondary reference by Williams et al teaches in column 8, lines 61-68 and column 9 line 3, the printing of "proof copies of the original document, the number being determined by the operator's instructions entered via keyboard..." and when "...acceptable, the operator can instruct the press to print the required number of final copies." Also, Williams et al takes into account that "[i]f changes are required, new printing plates can be made..." The point here is that Williams et al's reference accounts for changes in "proof" (test) copies and the ability to change the number of copies to any value based on user input. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a step of resetting the number of copies to a designated value when test printing is involved as taught by the Williams et al reference in light of the Shima et al invention. The motivation is to be able to print the appropriate number of copies if the test print is deemed to be acceptable.

***Allowable Subject Matter***

Claims 6-11 are allowed. The reason is that no references were found to be sufficient in rejecting the concept of a "spool file manager that checks if a print instruction is a test print instruction..."

**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is 703-306-4142. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
YQ

Yixing Qin  
Examiner  
Art Unit 2622  
8/30/2004

  
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